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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,961	01/23/2004	Jens Beger	HOE-593.1	7911
20028	7590	05/05/2005	EXAMINER	
Lipsitz & McAllister, LLC 755 MAIN STREET MONROE, CT 06468			RAMANA, ANURADHA	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

②

<b>Office Action Summary</b>	Application No. 10/763,961	Applicant(s) Beger et al.	
	Examiner Anu Ramana	Art Unit 3732	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5, 6 and 9-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5, 6 and 9-16 is/are allowed.
- 6) ☒ Claim(s) 17 and 20-29 is/are rejected.
- 7) ☒ Claim(s) 18 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

The indicated allowability of claims 17 and 20-29 in the office action mailed on November 15, 2004 is withdrawn in view of newly discovered references. Rejections based on the newly cited references follow.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17, 20-25 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Fiz (US 6,241,731).

Fiz discloses a plate and screw assembly including a bone screw 1 having a head 3 with an annular groove 9 for receiving projections or "snap catches" 10 of a resilient cap or "clamping element" 7 (Figs. 1, 2A-2D, col. 1, lines 6-15, col. 3, lines 66-67 and col. 4, lines 1-19).

The method steps of claims 17, 20-25 and 28 are inherently performed during normal use of the Fiz assembly for bone fixation.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fiz (US 6,241,731) as applied to claim 17 above, further in view of Bray (US 6,235,034).

Fiz discloses all elements of the claimed invention except for a targeting instrument for placement of screw 2.

It is well known to place a bone screw guide device or targeting instrument on a plate for placing bone screws in the plate, as evidenced by Bray (Figs. 9 and 10 and col. 6, lines 46-63).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided targeting instrument, as taught by Bray, for placement of screws in the plate of the Fiz assembly.

The claimed method steps are rendered obvious by the above discussion.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fiz (US 6,241,731) as applied to claim 17 above, further in view of Schenk (US 5,997,541).

Fiz discloses all elements of the claimed invention except for a cannulated screw.

Schenk teaches a providing a bore 66 or a "cannula" in a screw 60 for receiving a guide wire (col. 5, lines 22-28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a bore in the Fiz screw, as taught by Schenk, for receiving a guide wire or "Kirschner wire."

The claimed method steps are rendered obvious by the above discussion.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fiz (US 6,241,731) as applied to claim 17 above, further in view of Simonson (US 5,681,135).

Fiz discloses all elements of the claimed invention except for a screw having internal threads in cannulated portion thereof.

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Simonson teaches a providing an internally threaded cannulated portion in a screw to enable screw removal during surgical procedures (Fig. 2, col. 6, lines 58-67 and col. 7, lines 1-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the Fiz screw with an internally threaded cannulated portion to enable screw removal.

The claimed method steps are rendered obvious by the above discussion.

### ***Allowable Subject Matter***

Claims 5-16 are allowed.

Claims 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR

*Anuradha Kanara*

May 2, 2005

*Kevin Shaver*  
KEVIN SHAVER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700